

Claim 12, which is the main claim, has been amended to recite that:

1. The adhesive tape has one side covered by a contact adhesive. This is shown in Figure 1, where tape 1 is coated with adhesive 3. Further support is found at page 6, paragraph describing what the figures show.
2. The masking paper is adhered to and only partially covers the adhesive coated side of the masking tape. This is supported by the figures, wherein the masking paper is shown adhered to the adhesive coated side of the adhesive tape at 4, covering the part of the adhesive coated side of the tape at area 4, but leaving the remaining part of the adhesive coating 3 uncovered. Thus, the adhesive paper is shown to be adhered to but only partially covering the adhesive coated side of the tape.
3. The masking film is adhered to but only partially covers the part of the adhesive coated side of the tape that is left uncovered by the masking paper, overlaps the paper and has a width that exceeds the width of the paper. It is clear from the drawings that the view in each drawing is a cross-sectional view, and that the width of each of the tape, the masking paper and the masking film runs from the top to the bottom, as depicted. That the masking film is adhered to and only covers the part of the adhesive side of the tape left uncovered by the masking paper is seen by the locus of the attachment of the film to the adhesive tape above area 4, as depicted. The remainder

of the adhesive tape above the point where the adhesive film is adhered to it is left uncovered. That the width of the masking film exceeds the width of the masking paper is seen in Fig. 3, where the top part of the masking film, where adhered to the masking tape, extends beyond the upper width boundary of the masking paper, and where the lower part of the masking film 6 extends beyond the lower width boundary of masking paper 5.

Thus, the limitations of claim 12, as amended, are fully supported by the specification and drawings.

Claims 2-9 and 12 stand rejected under 35 U.S.C. 112, first paragraph, because the specification does not mention a first side, second side, first edge or second edge and the Examiner further sees the specification as not supporting "said second edge of said masking film extending beyond said second edge of said masking paper".

The specification and drawings describe and illustrate a tape, to which is attached a masking paper and a masking film. Each of these components inherently has two sides and two edges. Thus, there is full support for a first side, a second side, a first edge and a second edge. In the figures, it can be seen that one of the edges of the masking paper extends beyond one of the edges of the tape, whether those edges are called first or second edges. Same for the masking film. Thus, the foregoing terms are fully supported by the specification and drawings.

Nevertheless, in a determined effort to advance the prosecution of this case, Applicants have reworded their main claim using alternative terminology that is even more clearly fully supported, as discussed above.

The rejection of claims 2-9 and 12 under 35 U.S.C. 112, first paragraph should now be withdrawn.

Claims 2-9 and 12 stand rejected under 35 U.S.C. 103(a) as obvious over Patel (US 5,385,783) in view of Sakumoto (US 5,683,806). The Examiner sees the combination of references as disclosing tapes made of the same materials as Applicants', and sees the differences as being only in the way those materials are arranged. The Examiner cites In re Japiske 86 USPQ 70 for the proposition that rearranging the parts of the invention involves only routine skill:

However, In re Japiske 86 USPQ 70 was concerned with a switch, and held that "...there would be no invention in shifting the starting switch...to a different position since the operation of the device would not thereby be modified".

First of all, Neither Patel nor Sakumoto discloses the elements of Applicants' invention. In both of these references, tapes are disclosed, one of which is a composite, but none of which concerns a masking paper adhered to and covering only a part of the adhesive coated side of a tape and which has a width which extends beyond one width boundary of the adhesive tape, or a masking film which is adhered to and only partially

covers the uncovered remaining part of the adhesive coated side of the tape and which covers the masking paper, and exceeds its width.

There is no way to "rearrange" the elements disclosed in the references to arrive at Applicants combination of elements.

Applicants elements are different, and they function differently than anything disclosed or suggested in Patel or Sakumoto, whether taken individually or in any combination. These differences cannot be overcome by any "rearrangement" of Patel or Sakumoto's materials.

Clearly Japiske is not applicable, as the differences between the present invention and the articles disclosed in the references are far more than the relocation of a switch while maintaining the same function.

The rejection of claims 2-9 and 12 stand under 35 U.S.C. 103(a) as obvious over Patel (US 5,385,783) in view of Sakumoto (US 5,683,806) should accordingly now be withdrawn

In view of the present amendments and remarks it is believed that claims 2-9 and 12 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited. Should the Examiner not deem the present amendment and remarks to place the instant claims in condition for allowance, it is respectfully requested that this Amendment Under Rule 116

be entered for the purpose of placing the prosecution record in better condition for appeal.

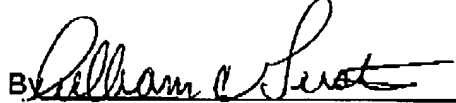
CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this amendment is required, applicants request that this be considered a petition therefore. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

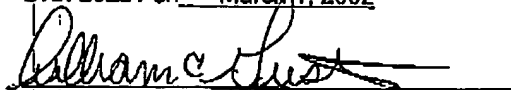
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I hereby certify that this correspondence is being transmitted via facsimile addressed to BOX AF, Assistant Commissioner for Patents, Washington, D.C. 20231 on March 1, 2002



Date March 1, 2002

**MARKED-UP COPIES OF AMENDED CLAIMS, SHOWING CHANGES RELATIVE TO PREVIOUS VERSION(S).**

Claim 12 (amended). A self-adhesive masking strip, comprised of

- a) a heat-resistant adhesive tape [having] comprising a paper support [with a first side, a second side, a first edge, a second edge, a marginal area adjacent the second edge; the second] one side of which is coated with a [self-] contact adhesive [composition];
- b) a masking paper [having a first edge and a second edge, and a marginal area adjacent the first edge; said marginal area of said masking paper being attached to the marginal area adjacent the second edge of said adhesive-coated paper support, on the adhesive-coated side thereof; said second edge of said masking paper extending beyond said second edge of said paper support] adhered to and only partially covering said one side of said adhesive tape and having a width which extends from the locus of its adhesion to said one side of said adhesive tape to beyond one width boundary of said adhesive tape; and
- c) a masking film adhered to and only partially covering the part of said one side of said adhesive tape left uncovered by said

masking paper, and which overlaps and covers said masking paper and has a width which exceeds the width of said masking paper [having a first edge and a second edge, and a marginal area adjacent the first edge, said marginal area of said masking film being attached to the marginal area of the adhesive-coated side of said paper support at an area which lies further from said second edge of said paper support than said marginal area of said masking paper; said masking film covering said masking paper; said second edge of said masking film extending beyond said second edge of said masking paper].